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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,239	09/19/2006	Thomas Schnelle	606212000100 3800	
	7590 02/18/200 FOERSTER LLP	EXAMINER		
425 MARKET	STREET		KINGAN, TIMOTHY G	
SAN FRANCISCO, CA 94105-2482			ART UNIT	PAPER NUMBER
			1797	
			MAIL DATE	DELIVERY MODE
			02/18/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)					
Office Action Commence	10/556,239	SCHNELLE ET AL.					
Office Action Summary	Examiner	Art Unit					
	TIMOTHY G. KINGAN	1797					
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address					
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period w  - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 6(a). In no event, however, may a reply be timil apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).					
Status							
1)⊠ Responsive to communication(s) filed on <u>08 No</u>	ovember 2005						
,— · · · · · · · · · · · · · · · · · · ·	action is non-final.						
	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
·— · · ·	closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.						
·	A parto Quayro, 1000 O.B. 11, 10						
Disposition of Claims							
4)⊠ Claim(s) <u>1-41</u> is/are pending in the application.	4) Claim(s) <u>1-41</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.							
5) Claim(s) is/are allowed.							
6) Claim(s) is/are rejected.	6)☐ Claim(s) is/are rejected.						
7) Claim(s) is/are objected to.	_						
8) Claim(s) <u>1-41</u> are subject to restriction and/or e	8) Claim(s) 1-41 are subject to restriction and/or election requirement.						
Application Papers							
9)☐ The specification is objected to by the Examiner.							
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.							
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).							
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.							
Priority under 35 U.S.C. § 119							
2)⊠ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).							
	<ul> <li>a)  All b)  Some * c) None of:</li> <li>1.  Certified copies of the priority documents have been received.</li> </ul>						
<u> </u>							
	2. Certified copies of the priority documents have been received in Application No						
<del>_</del> · · · · · · · · · · · · · · · · · · ·	3. Copies of the certified copies of the priority documents have been received in this National Stage						
application from the International Bureau (PCT Rule 17.2(a)).							
* See the attached detailed Office action for a list of the certified copies not received.							
Au							
Attachment(s)  1) M Notice of References Cited (RTO 902)  4) Unitorious Summers (RTO 412)							
1) Notice of References Cited (PTO-892)  4) Interview Summary (PTO-413)  2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  Paper No(s)/Mail Date							
3) Information Disclosure Statement(s) (PTO/SB/08)  5) Notice of Informal Patent Application							
Paper No(s)/Mail Date 6) Other:							

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## **DETAILED ACTION**

## Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-18, drawn to a process for treating at least one particle in a channel with the step of contactless fixing.

Group II, claim(s) 19-35, drawn to a microfluidic device comprising a channel and a holding device for holding at least one particle.

Group III, claim(s) 36-41, drawn to an arrangement of electrodes for holding suspended particles in a fluidic system.

2. The inventions listed as Groups I, II and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The inventions of Groups I, II and III comprise a process and a device and the common technical feature of a fluidic microsystem with means for contactless holding of at least one particle. Such process and device with means for holding lack novelty over the prior art. For instance, U.S. Patent Application Publication 2002/0181837 (M. Wang et al.) discloses microfluidic devices with channels comprising a radiation transparent substrate and their methods for use in selective manipulation or trapping with optical pressure forces (contactless holding).

Further, the invention of Group III, a fluidic device with channels and a holding means comprising an arrangement of electrodes for contactless holding of particles does not distinguish over the prior art: U.S. Patent Application Publication 2002/0088712 (R. R. Miles) discloses fluid devices with channels and dielectrophoretic means for trapping cells or particles by switching of electric fields created by pairs of electrodes.

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3. A telephone call was made to Peter Yim on 02/03/2009 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

4. The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product

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are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMOTHY G. KINGAN whose telephone number is (571)270-3720. The examiner can normally be reached on Monday-Friday, 8:30 A.M. to 5:00 P.M., E.S.T..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TGK /Jill Warden/

Supervisory Patent Examiner, Art Unit 1797